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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,751

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Hiroyuki Kedula

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EXAMINER

ROE, JESSEE RANDALL

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

10/25/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary

Application No.

10/501,751

Applicant(s)

KEDUKA ET AL.

Examiner

Jessee Roe

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

Claims 1-7 are pending wherein claims 1-4 are amended and claim 7 is new.

Status of Previous Rejections

The previous rejection of claims 1-5 under 35 U.S.C. 102(b) as being anticipated by Durrwachter (US 3,785,810) is withdrawn in view of the Applicant's amendments to the claims. The previous rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Durrwachter (US 3,785,810) as applied to claim 1 above, and further in view of Takashi et al. (JP 2002-015464) is withdrawn in view of the Applicant's amendments to the claims. The previous rejection of claim 1 on the ground of nonstatutory obvious-type double patenting as being unpatentable over claims 1-2 of copending Application No. 10/534288 is withdrawn in view of the Applicant's amendments to the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Shibata (US 4,636,270).

In regards to claim 1, Shibata ('270) discloses making an electrical contacts out of an alloy of Ag-Sn 8%-In 4% (col. 3, lines 13-16).

With respect to the recitation "A silver alloy for use in a reflection coating for an optical recording medium" has been considered, but has not been allotted patentable weight because the recitation does not limit the structure of the silver alloy. MPEP 2111.02 II.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata (US 4,636,270).

In regards to claims 2-3 and 5, Shibata ('270) discloses a silver-tin alloy system made by the complete internal oxidation of an alloy comprising 0.5-12 weight percent *tin*, 0.5-15 weight percent *indium* or 0.01 – less than 1.5 weight percent bismuth, to which alloy may be added **one or more** metallic elements selected from a group consisting of 0.10 – 5 weight percent cadmium, 0.1 – 2 weight percent zinc, 0.10 – 2 weight percent antimony, 0.01 – 2 weight percent lead, and 0.10 – less than 2 weight percent *indium*. The Examiner notes that the compositions disclosed by Shibata ('270) overlaps the compositions of the instant invention, which is a prima facie case of

obviousness. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed amounts of indium and tin from the compositions disclosed by Shibata ('270) because Shibata ('270) discloses the same utility throughout the disclosed ranges.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrano et al. (US 6,139,652).

In regards to claims 1-4, Carrano et al. ('652) discloses a silver alloy composition having at least about 99.5 weight percent with the balance selected from the group consisting of aluminum, antimony, cadmium, gallium, germanium, indium, lithium, manganese, magnesium, silicon, tin, titanium, and zinc (col. 1, lines 48-58 and Tables 1-3). The Examiner notes that the compositions disclosed by Carrano et al. ('652) overlap the compositions of the instant invention, which is a prima facie case of obviousness. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed amounts of indium and tin from the compositions disclosed by Carrano et al. ('652) because Carrano et al. ('652) discloses the same utility throughout the disclosed ranges.

In regards to claim 5, Carrano et al. ('652) discloses hardening by internal oxidation (col. 1, lines 58-67).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata (US 4,636,270) as applied to claim 1 above, and further in view of Okamura et al. (US 6,104,530).

In regards to claim 6, Shibata ('270) discloses a silver-tin-indium alloy as shown

above, but Shibata ('270) does not specify that the silver-tin-indium alloy would be used as a sputtering target.

Okamura ('530) discloses that a silver or silver containing alloy would be used as a sputtering target in order to enable the metal film layers consisting of silver or silver-containing alloy and the high-reflective-index transparent film layers to be formed easily (col. 11, line 45 – col. 12, line 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the silver-tin-indium alloy, as disclosed by Shibata ('270), as a sputtering target as disclosed by Okamura ('530), in order to enable the metal film layers consisting of silver or silver-containing alloy and the high-reflective-index transparent film layers to be formed easily, as disclosed by Okamura ('530) (col. 11, line 45 – col. 12, line 8).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carrano et al. (US 6,139,652) as applied to claim 1 above, and further in view of Okamura et al. (US 6,104,530).

In regards to claim 6, Carrano et al. ('652) disclose a silver alloy composition as shown above, but Carrano et al. ('652) do not specify that the silver alloy would be used as a sputtering target.

Okamura ('530) discloses that a silver or silver containing alloy would be used as a sputtering target in order to enable the metal film layers consisting of silver or silver-containing alloy and the high-reflective-index transparent film layers to be formed easily (col. 11, line 45 – col. 12, line 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the silver alloy, as disclosed by Carrano et al. ('652), as a sputtering target as disclosed by Okamura ('530), in order to enable the metal film layers consisting of silver or silver-containing alloy and the high-reflective-index transparent film layers to be formed easily, as disclosed by Okamura ('530) (col. 11, line 45 – col. 12, line 8).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata (US 4,636,270) as applied to claim 1 above, and further in view of Shibata et al. (US 6,338,889).

In regards to claim 7, Shibata ('270) discloses a silver-tin alloy system as shown above, but Shibata ('270) does not specify that the silver-tin alloy would be used in an optical recording medium having a reflection coating consisting of the silver alloy.

Shibata et al. ('889) discloses that a silver metal or silver alloy would be preferred for an optical information recording disc in order to have a light reflecting layer that would have a high reflection to the laser light (abstract and col. 6, lines 22-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the silver-tin alloy system, as disclosed by Shibata ('270), for the light reflecting layer of the optical information recording disc, as disclosed by Shibata et al. ('889), in order to achieve a high reflection to the laser light, as disclosed by Shibata et al. ('889).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carrano et al. (US 6,139,652) as applied to claim 1 above, and further in view of Shibata et al.

(US 6,338,889).

In regards to claim 7, Carrano et al. ('652) disclose a silver alloy composition as shown above, but Carrano et al. ('652) do not specify that the silver alloy would be used in an optical recording medium having a reflection coating consisting of the silver alloy.

Shibata et al. ('889) discloses that a silver metal or silver alloy would be preferred for an optical information recording disc in order to have a light reflecting layer that would have a high reflection to the laser light (abstract and col. 6, lines 22-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the silver alloy composition, as disclosed by Carrano et al. ('652), for the light reflecting layer of the optical information recording disc, as disclosed by Shibata et al. ('889), in order to achieve a high reflection to the laser light, as disclosed by Shibata et al. ('889).

Response to Arguments

Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessee Roe whose telephone number is (571) 272-5938. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JR


ROY KONG
SENIOR PATENT EXAMINER
EBC, ART UNIT 1700